

REMARKS

I. STATUS OF THE CLAIMS

Claims 1-9, 11-15, and 17-34 are pending. Without prejudice or disclaimer, Claims 1, 13, and 15 are amended to further clarify the claimed subject matter. Exemplary support can be found throughout the specification and claims as filed, for example, at paragraph [026] in the specification as filed.. Further, Applicants believe that the proviso added to the claims is fully supported by the specification as filed. Applicants assert that they are simply claiming less than the full scope of the disclosure – a legitimate procedure for inventors entitled to decide the bounds of protection they seek. *See, e.g., In re Johnson*, 558 F.2d 1008 (C.C.P.A. 1977). Accordingly, no new matter has been added.

Applicants respectfully acknowledge the Examiner's withdrawal of the previous rejections under 35 U.S.C. § 103 (a).

II. REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

The Examiner rejects Claim 13 under 35 U.S.C. § 112, second paragraph as allegedly "being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Office Action at 2. Specifically, the Examiner asserts that the compounds (v) and (vi) recited in Claim 13 "contradict" the proviso recited in Claim 1. *See id.* at 2-3.

Applicants respectfully disagree and traverse. When determining a claim's definiteness in compliance with 35 U.S.C. § 112, second paragraph, the Examiner's focus should be whether the claim meets "the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available."

M.P.E.P. § 2173.02. Moreover, claim definiteness must be analyzed, not in a vacuum, but in light of: "(A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made." M.P.E.P. § 2173.02.

Accordingly, Applicants assert that the language of Claim 13 is clear and does not contradict the proviso language of Claim 1. Both before and after the current amendments, the definition for variable Z in compounds (v) and (vi) recited in Claim 13 is either 2-C₁₋₄ alkyl-propylene, 2,2'-disubstituted propylene, or butylene. Consequently, the definitions of Z in (v) and (vi) are structurally different from the definition of Z in both the original proviso and amended proviso in Claim 1. Thus, the alleged contradiction does not exist. As such, Applicants respectfully submit that this rejection is in error and should be withdrawn.

III. REJECTIONS UNDER 35 U.S.C. § 102

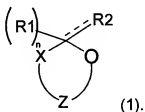
The Examiner rejects Claims 1-4, 14-15, 18-23, 27 and 31-34 under 35 U.S.C. § 102 (a) and (e) as being allegedly anticipated by U.S. Patent 6,495,150 to Bekele (hereafter "*Bekele*"). In making the rejection, the Examiner contends, at page 3 of the Office Action, that *Bekele* "teaches cosmetic compositions comprising a functionalized acid anhydride of formula given in col.2, where X is a cosmetic benefit agent and reads on instant variable z, which is substituted." Applicants respectfully disagree and traverse for at least the following reasons. A claim is anticipated under 35 U.S.C. § 102(b) **only** if each and every element as set forth in the claim is found in a single

reference. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) and M.P.E.P. § 2131.

Bekele teaches a topical composition comprising a functionalized acid anhydride-based bonding agent with the structure reproduced below: *Bekele* at col. 1, lines 54-67, and at col. 2, lines 5-20.



As indicated by their chemical nomenclatures, and without considering the nature of the X in *Bekele*, the acid anhydride-based compounds of *Bekele*, are structurally distinct from the cyclic carbonates of claimed Formula (1), reproduced in part below, wherein X is O or S:



For example, *Bekele*'s acid anhydride-based compounds have one heteroatom (O) within the ring, and two carbonyls attached to said oxygen atom.

In contrast, the cyclic carbonates of claimed Formula (1) have at least two heteroatoms (O or S) within the carbonate ring, and at most one carbonyl, which bridges said two heteroatoms. Accordingly, whether or not the X in *Bekele* reads on Z does not constitute a base of 102 rejection in this case. As discussed above, *Bekele* does not teach claimed Formula (1), let alone present Claim 1. Accordingly, Applicants respectfully submit that this rejection is in error and requests its withdrawal.

IV. REJECTIONS UNDER 35 U.S.C. § 103

The Examiner rejects Claims 1-9, 11-15, and 17-34 under 35 U.S.C. § 103(a) as allegedly "being unpatentable over" Japanese Patent Application Publication 2001-158724 to Megumi et al. (*Megumi*) for reasons set forth at pages 4-5 of the Office Action. In particular, the Examiner contends that while *Megumi* "does not exemplify compounds other than those in examples 3-5, [*Megumi*] teaches all of the compounds have the above advantages and accordingly, absent evidence to the contrary, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention was made to choose any of the compounds described by formula I of [*Megumi*] with an expectation to achieve safe and highly effective hair dyeing effect." Applicants respectively disagree and traverse for at least the following reasons.

Several basic factual inquiries must be made in order to determine whether the claims of a patent application are obvious under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 USPQ 467; *see also* *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1734 (2007).

"The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious."

M.P.E.P. § 2142. It is important to note, moreover, when ascertaining the differences between the prior art and the claims at issue, the Examiner must consider “both the invention and the prior art references as a whole.” M.P.E.P. § 2141.02. Indeed, “the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (citations omitted) (emphasis original).

Applicants note that *Megumi* does not teach the compounds of the presently amended claims.¹ Moreover, the Examiner has not demonstrated that *Megumi* provides the requisite motivation or suggestion to modify its compounds and teachings to arrive at the present claims. Thus, *Megumi* does not render the present claims obvious. Accordingly, Applicants respectfully request the rejection be withdrawn.

¹ Applicants note that isopropylene is no longer individually recited because it is included in the newly added proviso compounds.

V. CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and timely allowance of the pending claims.

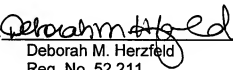
If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, she is respectfully invited to contact Applicants' undersigned counsel at (202) 408-4368.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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By: 
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